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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/624,350

07/21/2003

Sascha Kreiskott

S-99,952

9406

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7590

05/18/2007

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EXAMINER

SMITH, NICHOLAS A

ART UNIT

PAPER NUMBER

1742

MAIL DATE

DELIVERY MODE

05/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/624,350

Applicant(s)

KREISKOTT ET AL.

Examiner

Nicholas A. Smith

Art Unit

1742

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 May 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 19 March 2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 5. Applicant's reply has overcome the following rejection(s): In regards to rejections made under Arendt '150 (US 2003/0144150) as USC 102(e) prior art, Applicant provides a statement that the named inventors of Arendt '150 and the instant application were employees of the University of California (UC) at the the the claimed invention was made and therefore subject to an obligation of assignment to UC (see remarks, p. 5-6, submitted 2 May 2007). Therefore, the 35 USC 103(a) rejection under Arendt '150 is withdrawn.

Continuation of 11. does NOT place the application in condition for allowance because: In regards to Applicant's argument that 37 CFR 1.132 declaration filed 18 September 2006 supports evidence of conception, Examiner notes that declaration only provides a conclusion statement, but no technical analysis how 37 CFR 1.131 evidence and instant claims are commensurate in scope; therefore, Qiao (provisional appliation 60/483,956) is considered a reference and the rejection is maintained. In regards to Applicant's argument that Arendt et al. '483 (US 2003/0036483) in view of Rosswag (US 4,372,831) does not teach or suggest the claimed invetion, Applicant is reminded that Arendt et al. '483 teaches the step of electropolishing (paragraph [0015]) to provide a smoother surface. Rosswag teaches that current density is a result effective variable in that a mirror gloss is obtained at higher current densities. One of ordinary skill in the art would apply a higher current density to get the desired RMS roughness. Applicant futher defines mirror gloss as 20 nm or less (see declaration, 2 May 2007, p. 2). In the instant case, in order to achieve a RMS roughness of 4 nm, one of ordinary skill in the art would increase the current density to achieve that RMS roughness as taught by Rosswag. Therefore, the 35 USC 103(a) rejection under Arendt '483 in view of Rosswag is maintained. The 35 USC 103(a) rejection under Glówacki (Texture developments in long lenth of NiFe tapes for superconducting coated conductors, J. of Mater. Sci., vol. 37, no. 1, pp. 157-168, Jan. 2002) in view of Rosswag is maintained for the same reasons as stated above.


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